

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Dunn et al.**

Serial No : **10/757,109**

Group Art Unit: **3749**

Confirmation No.: **2938**

Filed: **January 14, 2004**

Examiner: **Abott, Yvonne R.**

For: **STYPTIC APPLICATOR WITH FILE**

Honorable Commissioner for Patents
P O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is a response to the Examiner's Answer dated December 12, 2007, in relation to the above-identified application:

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

This Reply Brief is submitted in response to the Examiner's Answer dated December 12, 2007. Reconsideration and allowance is respectfully requested in view of the remarks made below.

1. New Grounds of Rejection

Claims 11, 30 and 57 have been newly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,273,559 to Burnett (hereinafter "Burnett").

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." See *MPEP 2143.03*.

The Examiner's newly provided rejection still does not address the deficiencies that have previously been noted regarding the disclosure of Burnett. Claims 11, 30 and 57 depend either directly or indirectly from claims 1, 23 and 47. Claims 1, 23 and 47 each require a styptic. Burnett simply has no disclosure of styptic. The Examiner's answer still fails to address this glaring omission in Burnett and attempts to do so by suggesting that any powder is styptic. See *the Examiner's Answer*, pp. 3 and 8. This is clearly faulty logic. Not all powders are styptic, much like not all animals are dogs.

Therefore, each and every limitation of the claims is not met by the prior art and thus a *prima facie* case for obviousness has not been properly established with respect to claims 11, 30 and 57.

It is additionally noted that one of ordinary skill in the art would not have modified Burnett in the manner required by claims 11, 30 and 57 for the reasons suggested by the Examiner.

“If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See *MPEP 2143.01*

The Examiner in the newly provided rejection states that although it is not disclosed in Burnett that the filing device has a herringbone pattern, such a pattern would have been obvious. The Examiner’s rationale for modifying Burnett’s invention in such a manner is provided below:

“it would have obvious to one of ordinary skill in the art at the time the invention was made to provide that the filing device have a herringbone cross-hatch pattern as one of many various cutting/trimming patterns in order to maximize the release of the filed substance to thereby increase the filing effect. Additionally, a herringbone pattern would facilitate ease in gripping the file device. Further, to make the pattern of the Burnett file herringbone is considered to be an obvious design modification lacking disclosed criticality since with respect to a herringbone pattern, Appellant states only that their “filing device 14 can be made of any number of materials including emery board material, metal, sandpaper, etc. In a preferred embodiment the filing device will have a herringbone crosshatch.” See the *Examiner’s Answer*, pp. 4-5.

It is first noted that this newly provided rejection is merely conjecture by the Examiner. No evidence has been provided that teaches using a herringbone pattern in the filing of nails, let alone for the usage of filing the nails of animals. The Examiner has not provided any suggestion from the prior art for doing so. Besides this lack of evidence on the part of the Examiner, the Examiner has also failed to provide proper motivation for modifying the file disclosed by Burnett in order to achieve the device as claimed.

As discussed in the Brief, Burnett teaches a compact vanity case that a human may use. The Examiner’s rationale that one would modify Burnett in order “to maximize the release of the filed substance to thereby increase the filing effect” is not a logical one in

the context of the disclosure of Burnett, which indicates that the disclosed device is intended for use with human fingernails as well to avoid damaging the interior of a purse. See *Burnett*, col. 1, lines 1-20. The Examiner's suggestion that one would modify Burnett in order to increase the filing effect does not take into account that the file in Burnett would be used for human nails, while the file of the Appellant's invention is to be used with animal nails, which are thicker and more coarse than human nails. The factors that one takes into account in order to obtain a manicured effect in humans are different than those taken in order to obtain well groomed pet nails.

The Appellant respectfully submits that one of ordinary skill in the art would not modify the file in Burnett in order to increase the amount of nail material removed, as suggested by the Examiner, since such enhanced nail removing ability would render the file unsatisfactory for the purpose of manicuring human nails.

Furthermore, as suggested by the Examiner, facilitating the ease with which one grips the file device is immaterial in the context of the Burnett disclosure since, Burnett explicitly teaches using the receptacle 6 as the handle for the file 21. See *Burnett*, col. 2, lines 20-23.

As discussed above, the proposed modification of Burnett, as suggested by the Examiner, would render Burnett unsatisfactory for its intended purpose. For at least these additional reasons claims 11, 30 and 57 are in condition for allowance.

2. Reply to the Examiner's Response

a. The rejections under 35 U.S.C. 102(b)

The Examiner responds to the brief by stating that "Burnett clearly shows a chamber for holding a powder (10), which is well known to be used as a clotting or styptic material." See *Examiner's Answer*, p. 8. The Appellant respectfully submits that the statement that a powder "is well known to be used as a clotting or styptic material," is unsupported by any evidence and is clearly logically flawed.

There is absolutely no mention of a styptic material in Burnett. Merriam-Webster's online dictionary defines styptic as "tending to contract or bind : ASTRINGENT; *especially* : tending to check bleeding." See www.m-w.com. A "styptic material" is a chemical or substance that is used in order to stop bleeding. This is used in the Appellant's invention because during the grooming of some animals, such as dogs, when a nail is clipped, the veins that are embedded within the nail may be damaged thereby causing bleeding. The Examiner points to the disclosure of "powder" in Burnett and suggests that this is enough to provide teaching of a styptic material. Merriam-Webster's defines powder as "matter in a finely divided state: particulate matter." See www.m-w.com. The powder used in Burnett is clearly for cosmetic purposes not for the usage of stopping bleeding. Simply because a type of material may take the physical form of a powder is not sufficient to provide teaching of the material itself. By the same logic, the Examiner could suggest that a disclosure of a container for holding liquid (such as a juice bottle), would be sufficient to provide teaching of gasoline. This is clearly flawed.

Furthermore, the Examiner points to element 13 of Burnett and refers to it as a "spout or port." See the *Examiner's Answer*, pp. 8 and 9. The Appellant respectfully submits that this is in error. Discharge port 13 is clearly not a spout. Merriam-Webster's online dictionary defines a spout as a "projecting tube or lip from which a liquid (as water) issues." See www.m-w.com. The discharge port 13 in Burnett is clearly a tunnel through closure plug 11 and not a projecting tube.

Additionally, with respect to claims 5, 27 and 51, the Examiner additionally states that the "shank end of the file is considered to meet this limitation." The Appellant respectfully notes that the attachment member, as claimed, is an additional element that is part of the file and not the file itself. Therefore, the limitations of claims 5, 27 and 51 are not met.

For at least the above reasons the rejection under 35 U.S.C. 102(b) is in error and this error is not remedied by the Examiner's Answer.

b. The rejections under 35 U.S.C. 103(a)

On page 9 of the Examiner's Answer it is suggested that U.S. Patent No. 2,290,886 to Lenz (hereinafter "Lenz") discloses a handle on a removable cap. The Examiner points to the cap 25 and the elastic cord 27 which keeps the cap 25 attached to the outer tube 21 in Lenz. See *Lenz*, col. 2, lines 49-54. The elastic cord 27 is not a handle.

On page 9 of the Examiner's Answer, the Examiner again suggests that Burnett discloses an apparatus for dispensing styptic. As discussed above and in the Brief, Burnett does not disclose a styptic material.

On page 9 of the Examiner's Answer, the Examiner suggests that it would have been obvious to modify Burnett with the handle taught by Lenz in order to facilitate easy carriage and handling of the article. However, the Appellant notes that there is no motivation for modifying the vanity cases taught by Burnett with a cord on a styptic pencil. Since Burnett teaches placing the vanity case in a purse, there would be little reason to place a strap on the vanity case. Furthermore, there would be no reason for combining art from two disparate fields such as women's cosmetic cases and a styptic pencil.

On page 10 of the Examiner's Answer, the Examiner argues that "Burnett was applied to Griffiths, Jr. [U.S. Patent No. 5,762,077 to Griffiths, Jr. (hereinafter "Griffiths")] *solely to teach that the fluid is powder styptic*" [emphasis added]. The Appellant again notes that styptic is not taught in Burnett. Assuming *in arguendo* one were motivated to replace the nail polish with the powder disclosed in Burnett, you still would not arrive at the Appellants invention. The Appellant again maintains that the 35 U.S.C. § 103(a) rejection based on Griffiths in view of Burnett is clearly in error.

On page 11 of the Examiner's Answer, the Examiner argues that "Burnett was added [to U.S. Patent No. 5,897,262 to Bratby-Carey (hereinafter "Bratby-Carey")] to teach the obviousness of powder as the fluid in the Bratby-Carey applicator, especially since it is well known to apply powder (such as acrylic) to nails." The Appellant again notes that styptic is not taught in Burnett. Assuming *in arguendo* one were motivated to replace the fluid with the powder disclosed in Burnett, you still would not arrive at the Appellants invention. The

Appellant again maintains that the 35 U.S.C. § 103(a) rejection based on Bratby-Carey in view of Burnett is clearly in error.

It is additionally noted that adding styptic powder to a cosmetic device for humans is not obvious since humans do not have veins in their nails that would require the stoppage of bleeding and the usage of styptic. Burnett, Griffiths and Bratby-Carey are all related to cosmetic devices and are not used for the grooming of pets. It is not suggested in any of the references that their disclosed devices be used with pets. The Examiner still has not properly addressed this issue.

3. Conclusion

The Appellant has made an earnest effort to respond to the Examiner's Answer. If it is felt that a telephone interview would expedite prosecution of this patent application, the undersigned may be contacted at 215-599-0600. Also, contact with the undersigned via electronic mail at takupstas@patentwise.com is hereby authorized¹ per MPEP 502.03.

Respectfully submitted,

/Tod A. Kupstas/

Tod A. Kupstas
Registration No. 54,917

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KNOBLE YOSHIDA & DUNLEAVY, LLC
Eight Penn Center- Suite 1350
1628 John F. Kennedy Boulevard
Philadelphia, PA 19103
(215) 599-0600 Main
(215) 599-0601 Fax
takupstas@patentwise.com

¹ Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file.